THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Michael Weiss, et al.

Application No.: 09/768,129 Examiner: E.G. Milef

Filed: January 23, 2001 Docket No.: PERY 2 00002

For: CACHING MECHANISM TO OPTIMIZE A BIDDING PROCESS USED TO SELECT RESOURCES AND SERVICES

APPELLANTS' REPLY BRIEF UNDER 37 CFR 41.41

Appeal from Group 3628

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CERTIFICATE OF TRANSMISSION

I certify that Appellants' Reply Brief Under 37 CFR 41.41 is being filed on the date indicated below by electronic transmission with the United States Patent and Trademark Office via the electronic filing system (EFS Web).

4-8-08
Date

Elaine M. Checovich
Name Elaine M. Checovich

Status of Claims:

The status of the claims is as indicated in the Examiner's Answer.

Grounds of Rejection to be reviewed on Appeal - Pages 10 – 12 of the Examiner's Answer:

Examiner's Response to Argument against combination of Johnson et al (US 6,005,925), Yee et al (US 6,738,975), Baindur et al (US 6,073,176) and Kou (US 6,363,365) in rejecting claims 1 – 17 under 35 USC 103(a).

In all other respects, appellants maintain the arguments advanced in the Appeal Brief filed November 20, 2007.

Arguments:

On page 10 of the Examiner's Answer, Examiner notes appellants' argument that the combination of references does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In response, Examiner states that "*KSR* forecloses Appellants argument that a specific teaching is required for a finding of obviousness."

With respect, appellants do not argue "that a specific teaching is required for a finding of obviousness," as stated by the Examiner but rather "that the combination of references does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *KSR* does not foreclose appellants' argument "that the combination of references does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Indeed, the Opinion of the Court in *KSR* clearly states that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does."

In concluding obviousness of appellants' claimed "caching adapter for maintaining cached bids for predetermined contexts from predetermined ones of said bidder agents, and for receiving from said bid manager said call for bids and issuing said cached bids to said bid manager agent instead of requiring said predetermined bidder agents to issue said bid" Examiner's reason for modifying Johnson and Yee to include maintaining a default bid in memory [cached bid] as taught by Baindur is to allow the bidder to use the bid "if desired by the bidder to provide the bidder with various bidding options according to the bidder's capacity to process the event efficiently."

With respect, any "desire" of the bidder or any provision of various bidding options according to bidder's capacity to process the event efficiently is completely irrelevant to the claimed feature. Examiner's reason for combining Johnson, Yee and Baindur turns on the "desire" and "capacity" of each bidder, which is irrelevant to the

claimed "caching adapter for maintaining cached bids for predetermined contexts from predetermined ones of said bidder agents..."

Although the provision of **a** default bid in memory of **each** bidder, as taught by Baindur, may allow the bidder to use the bid "if desired by the bidder to provide the bidder with various bidding options according to the bidder's capacity to process the event efficiently," Examiner provides no reason as to why it would be obvious to modify Johnson and Yee with the teachings of Baindur to render obvious appellants'' claimed "caching adapter for maintaining cached bid**s for predetermined contexts from** predetermined ones of said bidder agent**s**...." The provision of a "default bid" in Baindur is clearly a predefined value (i.e., seed value = default base value + calibrated value-# of bundles owned by the stack member, per column 17, lines 54 – 56), and is not the equivalent of appellants' "cached bids", which are cached in the caching adapter (not the bidder) "for predetermined contexts." Examiner points to Johnson, column 3, for defining "predetermined contexts" by reference to "bidding moderator, carriers," It is unclear to appellants exactly how the reference to "bidding moderator, carriers" defines appellants "predetermined contexts." Indeed, the Court of Appeals for the Federal Circuit recently stated *In Re Icon Health and Fitness, Inc.*, "the PTO must give claims their broadest reasonable construction consistent with the specification...we look to the specification to see if it provides a definition for claim terms...." As previously argued on page 15 of the Appeal Brief, the term "context" is defined in the specification at page 4, lines 3 – 4 as "the set of values that the Bidders need to know in order to calculate their bids accordingly." Thus, if the "context" of a call for bids is identical to one that has occurred previously, the bid manager consults the cached bids in the caching adapter rather than send a call for new bids to bidders that have previously submitted bids for that context (i.e., the "predetermined ones of said bidder agents").

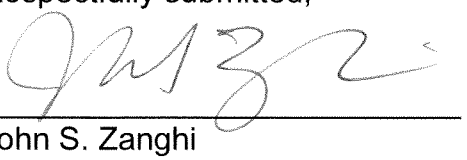
In any event, even if Johnson teaches "each of said bids defines a predetermined context," where does Baindur, or any of the cited prior art, teach or suggest caching of multiple bids in a caching adapter on the basis of "predetermined contexts" defined by the bids?

Finally, Examiner concedes that any judgement on obviousness must "not include knowledge gleaned only from applicant's disclosure." The maintaining in a caching adapter of cached bids for predetermined contexts can only be gleaned from applicants' disclosure.

CONCLUSIONS

For the reasons stated in appellants' Appeal Brief and as stated above, it is respectfully submitted that claims 1 -17 are in condition for allowance. Appellants respectfully request this Honorable Board to reverse the Examiner's rejection of claims 1 – 17.

Respectfully submitted,



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